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BY: Vicky Mini Date: August 4, 2003

MAIL STOP APPEAL BRIEF - PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Reissue Patent Application of Robert H. Staat	: Group Art Unit: 3617
Conf. No.	4290	:
Appln. No.:	08/999,730	: Examiner: S. Morano
Filed:	December 24, 1997	:
For U.S. Patent No.:	5,509,546	: Attorney Docket No. 7311-24RE
Granted:	April 23, 1996	:
Entitled:	MAGNETICALLY-ACTUATED COUPLER FOR MODEL RAILROAD CARS	:

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Commissioner for Patents
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is in furtherance of the Notice of Appeal, filed in this application by facsimile on June 4, 2003.

The fees required under § 1.17 are dealt with in the accompanying APPEAL BRIEF TRANSMITTAL LETTER. An earlier appeal was filed on December 3, 2001 and a brief was filed on February 20, 2002. In both instances, filing fees were paid.

This brief is transmitted in triplicate. (37 C.F.R. § 1.192(a)).

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. § 1.192(c)).

- I. REAL PARTY OF INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
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- X. APPENDIX OF ORIGINAL CLAIMS PROSECUTED IN PARENT APPLICATION 08/292,880
- XI. APPENDIX OF 37 C.F.R. § 1.109 FROM 7/1/1995 PTO EDITION

I. REAL PARTY OF INTEREST (37 C.F.R. § 1.192(c)(1))

The real party in interest in this appeal is Bachman Industries, Inc., assignee of U.S. Patent 5,509,546.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. § 1.192(c)(2))

There are no appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS (37 C.F.R. § 1.192(c)(3))

The status of the claims in this application are as follows:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 36 claims. (Claims 1-36)

Claims currently pending in the application: 35. (Claims 2-36)

B. STATUS OF ALL THE CLAIMS

- 1. Claims cancelled: 1
- 2. Claims withdrawn from consideration but not cancelled: NONE
- 3. Claims pending: 2-36

4. Claims allowed: 2-9, 11, 17, and 21-36

5. Claims rejected: 10, 12-16, and 18-20

C. CLAIMS ON APPEAL

The claims on appeal are: 10, 12-16, and 18-20

IV. STATUS OF AMENDMENTS (37 C.F.R. § 1.192(c)(4))

An Amendment After Final was filed on June 4, 2003 amending claims 35 and 36. The Examiner has indicated in an Office Action mailed June 12, 2003 that the proposed amendment(s) would be entered for purposes of Appeal and that the amended claims 35 and 36 would be allowed.

V. SUMMARY OF THE INVENTION (37 C.F.R. § 1.192(c)(5))

The following summary is provided without any intention to limit the scope of the claims. (All references are to the present application.)

Independent claim 10 is directed to a magnetically-actuated coupler assembly (10) for a model railroad car (Fig. 1, col. 2, lines 59-62). The claimed assembly comprises a drawbar (12) with first (14) and second (16) ends (Figs. 2-3, col. 2, lines 64-65). The first end (14) is configured for pivotal mounting within a coupler pocket (20) (col. 3, lines 5-10). A coupler head (22) is at the second end (16) (col. 3, lines 22-23). A magnetically-actuated post (28) is pivotally secured to the drawbar so as to extend downward from the drawbar (col. 3, lines 61-65). A coupler knuckle (26) is pivotally secured to the second end (16) of the drawbar (12) with the post (28) (col. 3, lines 61-65). The coupler head has a pair of stops (40, 42) which limit the pivotal movement of the coupler knuckle (26) on the drawbar (12) (col. 3, lines 29-32). A cantilever spring (24) is formed as an integral part of the drawbar (12) (col. 3, lines 51-55). The cantilever spring (24) includes a first portion which extends from the drawbar (12) proximally the coupler head (22) and curves away from the drawbar (12) and the coupler knuckle (26) and a free end which curves back toward the coupler knuckle (26) sufficiently so as to constantly apply a tangential force against the coupler knuckle (26) and urge the coupler knuckle (26) to a closed or coupled position in all positions of the coupler knuckle (26) between the pair of stops (40, 42) (Figs. 2 and 7, col. 3, lines 35-46).

Dependent claim 12 calls for the outer tip of the coupler knuckle (26) to contain a lip (50) (like original patent claim 3) (Fig. 7, col. 4, lines 11-13).

Dependent claim 13 calls for the drawbar (12) to include an extension lip (48) (like original patent claim 4) (Figs. 2 and 7, col. 3, lines 43-45).

Dependent claim 14 calls for the coupler knuckle to contain a slot, an edge (44) of which interacts with one of the stops (40, 42) of the coupler head (22) (like original patent claim 5) (Fig. 7, col. 3, lines 35-39).

Dependent claim 15 calls for the cantilever spring (24) and drawbar (12) to be molded together as a unitary piece from engineering plastic (col. 3, lines 58-60).

Independent claim 16 is similar in construction to independent claim 10 but contains different statements of the coupler knuckle (26) and the magnetically-actuated post (28) pivotally securing the coupler knuckle (26) to the coupler head (22).

Claims 18 through 20 depend from independent claim 16 and essentially parallel dependent claims 12 through 14.

VI. ISSUES ((37 C.F.R. § 1.192(c)(6))

Broadly, whether claims 10, 12-16, and 18-20 are unpatentable under 35 USC §251 as being an improper recapture of broadened claimed subject matter surrendered on the original application for patent from which this reissue application is based.

VII. GROUPING OF CLAIMS ((37 C.F.R. § 1.192(c)(6))

The appended claims 10, 12-16, and 18-20 are considered as standing or falling together.

VIII. ARGUMENTS ((37 C.F.R. § 1.192(c)(6)) REJECTIONS UNDER 35 U.S.C. 251 (37 C.F.R. § 1.192(c)(8)(v))

A. Factual Background

1. Prosecution of Parent U.S. Patent Application No. 08/292,880

Pertinent to these rejections is the prosecution of the original U.S. Application No. 08/292,880 as the Examiner's position relies entirely upon the prosecution history of that application. That original application was filed with one independent and five dependent claims. These claims are printed in their as filed form in the attached Appendix X together with

application claims 7 and 8 added by amendment. Original application claims 7 and 8 are claims 4 and 6 of the original application in independent form and with final, 112 corrections incorporated.

Original parent application claim 1 was directed to "a magnetically-actuated coupler assembly for a model railroad car" comprising six features: (a) a drawbar, (b) a integral leaf spring extending from one end of the drawbar, (c) a coupler head secured to a second end of the drawbar, (d) a cantilever spring secured to the drawbar, proximal the coupler body, (e) a magnetically-actuated post pivotally secured to the drawbar and (f) a pivotally mounted coupler knuckle, pivotally secured to the second end of the drawbar to interact with the cantilever spring to urge the coupler knuckle to a closed or coupled position.

The remaining original application claims 2-6 were dependent with claims 2-5 depending directly from claim 1 and claim 6 depending from claim 4. Claim 4 was directed to "(t)he magnetically actuated coupler assembly of claim 1 wherein the coupler body contains a pair of stops which limit the movement of the coupler knuckle".

In the first Office Action (Paper 2 mailed 5/18/95), all six claims were rejected under 35 U.S.C. 112, second paragraph, for allegedly confusing language in claims 1, 5 and 6. In addition, claims 1-3 and 5 were rejected over the prior art. Claims 4 and 6 were indicated to be allowable over the prior art if rewritten to overcome the 112 rejection and to include all limitations of the base claim and any intervening claim.

In a responsive Amendment filed July 31, 1995, claim 1 was amended to overcome the 112 rejection and the prior art rejection. Claims 4-6 were amended to conform to antecedent references and new independent claim 7 and dependent claim 8 were presented for examination. On page 3 of the Amendment, Applicant stated:

(A)pplicant has added new claims 7 and 8 which correspond to previous Claims 4 and 6 which are rewritten to overcome the rejections under 35 U.S.C. Section 112 and to include the limitations of the base claim and the intervening claim. (Applicant recognizes that these claims may be cancelled if amended Claims 1 and 4 are allowed).

Applicant argued for the allowability of claim 1-3 and 5 over the prior art but concluded his remarks for allowability of the claims on page 7 with the further statement:

Notwithstanding, the applicant has added new Claims 7 and 8 which correspond to Claims 4 and 6 rewritten to overcome the

rejections under 35 U.S.C. Section 112 and including all of the limitations of the base claim and any intervening claims.

On or about October 23, 1995, the Examiner initiated a telephone interview with the Applicant's former representative. According to the Examiner's summary of that Interview (Paper 5),

(The) Examiner initiated interview to suggest taking of allowable material in claims 4 and 6 so as to eliminate a repeat of the original rejection and new rejection based on the **exhibits filed with the protest**. Applicant agreed to the Examiner's suggestions. Other changes were to correct formalities in the claims, see examiner's amendment for agreed upon changes. [Emphasis added].

A third party had filed a protest in the application with prior art. Although the protest was not made of record, its receipt and the Examiner's consideration of its exhibits were expressly acknowledged by the Examiner in this interview summary.

The Examiner issued a contemporaneous Notice of Allowability (Paper No. 6B) with an Examiner's Amendment. The only changes made to either claim 7 or 8 were to claim 7. In line 11, the second occurrence of "the" was changed to --a pivotally mounted -- and, in line 16, "a" was changed to --the-- and ",", was changed to --is--. These reflect only Section 112 based objections to claim 7.

The Examiner further expressly set forth a Statement of Reasons for Allowance:

The combination of all of the features claimed in Claim 7, in particular with the use of two stops on the coupling head for limiting the pivotal movement of the coupler knuckle against the spring, is not found nor suggested by any of the prior art of record, including the exhibits of the protest filed 10/10/95.

Any comments considered necessary by Applicant must be submitted no later than the payment of the Issue Fee and, to avoid processing delays, should preferably **accompany** the Issue Fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance". [original emphasis]

The two stops referred to in the first above quoted paragraph were the only elements set forth in original parent application claim 4, which was presented in independent form as parent application claim 7. No comments were filed by the Applicant. The parent patent issued in due course on April 23, 1996. Application claim 7 became independent claim 1 while application claims 2-3, 5 and 8 became claims 2-5 of the subject U.S. patent.

2. Prosecution of Present U.S. Reissue Application No. 08/999,730

This reissue application was filed December 24, 1997, well within two years of the April 23, 1996 grant date of parent U.S. Patent No. 5,509,546. This reissue application was filed with a Preliminary Amendment canceling parent claim 1 and presenting a new independent claim 6 and new dependent claims 7-8 for examination. Original patent claims 2-5 were amended to depend directly or indirectly from new application claim 6.

Generally speaking, new independent claim 6 differed from cancelled patent claim 1 in that a portion of paragraph "c" in cancelled patent claim 1, specifically, the requirement for "a pair of stops" in the coupler head, was removed. Furthermore, the cantilever spring (paragraph (d) in original patent claim 1) was supplemented to further state how the cantilever spring had a first portion which curved away from the coupler body and a first end which curved back towards the coupler knuckle to apply a tangential force to the coupler knuckle. New reissue application dependent claims 7 and 8 recited specifically the molding of the cantilever spring and the cantilever spring and leaf spring, respectively, from engineering plastic.

A new independent claim 9 was further presented and directed to a magnetically-actuated coupler assembly including a drawbar capable of being pivotally mounted within the coupler pocket of a model railroad car, a leaf spring integrally formed at one end of the drawbar, a coupler head formed at a second end of the drawbar and a cantilever spring integrally formed with and extending from the drawbar near the coupler head. It further called for a pivotable coupler knuckle secured to the head and a magnetically-actuated post to pivotably secure the coupler knuckle to the coupler head. Claim 9 further expressly recited that the cantilever spring has a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle. Claim 9 also eliminated the requirement for stops in the coupler head that were required in patent claim 1.

The Examiner issued a first action allowance of the claims 2-9 on December 21, 1998, stating:

The combination of all of the features of the independent claims, including the newly added limitations of the particular shape and orientation of the cantilever spring relative to the pivoting knuckle, is not found or suggested by the prior art of record.

After Applicant filed a Declaration As To Loss Of Patent in response to the 12/21/98 Notice of Allowance, the Examiner issued a second Notice of Allowance of the reissue application on May 6, 1999.

On December 16, 1999, the Examiner initiated a telephone interview to discuss certain informalities which he thought existed in the application. In response, Applicant filed a Supplemental Amendment After Allowance with a Petition for Late Entry of Amendment on January 7, 2000, to incorporate certain minor changes agreed upon between the Examiner and applicant's prior representative to clarify existing language in patent claim 5 and to correct a reference in reissue application claim 9 lacking proper antecedent basis. A third Notice of Allowance was issued on February 28, 2000. Payment of the Issue Fee was submitted in May, 2000.

On September 22, 2000, the Examiner withdrew the February 2000 Notice of Allowance on the grounds that the Reissue Oath/Declaration was defective and that claims 2-9 were being rejected as being based upon a defective reissue declaration and also being an improper recapture of broadened claim subject matter surrendered in the original application for U.S. Patent 5,509,546. With respect to the latter, the Examiner asserted that "the combination of all of the features claimed in claim 7, in particular, with the use of two stops on the coupler head for limiting pivotal movement of the coupler knuckle against the spring" was part of the basis in the Examiner's allowance of the original claims in the parent U.S. Patent 5,509,546. The Examiner went on to state that:

Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered the broader coverage of no stops during the prosecution of the parent. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims by removing the limitations from the independent claims.

Claims 2-9 were indicated to be allowable over the prior art.

In response to the reopening of prosecution, the applicant filed on December 22, 2000, an Amendment which revised claims 6 and 9, and added new claims 10-21 for examination. More particularly, independent claim 6 and 9 were amended to include a requirement for a pair of stops as were essentially called for in originally granted patent claim 1. New independent claim 10 corresponded generally to independent claim 6 but deleted the express requirement for a leaf spring and added some further detail to the description of the cantilever spring which was claimed. It also expressly called for the pair of stops. New application claims 11-15 were

restatements of dependent claims 2-5 and 7, respectively, but depended from new independent claim 10.

New independent claim 16 corresponded generally to claim 9 but again deleted the requirement for a leaf spring and added some different detail concerning the cantilever spring. It also required the pair of stops. Dependent claims 17-21 were essentially restatements of claims 2-5 and 7 but depend from new claim 16.

In the Office Action mailed July 24, 2001, the Examiner indicated claims 2-8 were allowed while 9-21 were rejected under 35 U.S.C. §251 as being an improper recapture.

More specifically, the Examiner stated:

Specifically, the claims improperly remove limitations that the prosecution history of the parent application indicates were essential to the allowance of the application. The reasons for allowance in the original applicant specifically state that the allowance of the application was because of "the combination *of all of the features claimed in claim 7*, in particular, with the use of two stops on the coupling head for limiting pivotal movement of the coupler knuckle against the spring" (emphasis added). Because the application was allowed based on these limitations, and because applicant did not disagree with the reasons for allowance set forth by the examiner, applicant acquiesced and effectively surrendered broader coverage outside the scope of claim 7. Even though the claims were narrowed in another aspect, applicant still surrendered the right to broaden the claims beyond what the prosecution history indicated as being essential to patentability. It is suggested that the deleted material of claim 7 be reinstated in the independent claims to place the application in condition for allowance and eliminate the recapture.

Following that stated basis for rejection, the Examiner specifically indicated language that should be added to claims 9 through 21. That language was presented in new claims 22-34.

In the Telephone Interview held April 18, 2002, the Examiner indicated that the rejection of claims 9, 11, 17, and 21 based on recapture would be dropped pending reconsideration in light of the exhaustive arguments on the record in the first appeal. The Examiner indicated that because Applicant did not actually eliminate any of the elements of the originally allowed claims but simply broadened the scope of the claims, there was no recapture. The Examiner further indicated that the recapture rejection of claims 10, 12-16, and 18-20 would be maintained because Applicant actually eliminated the leaf spring from the allowable combination of claim 1.

In the Office Action mailed May 20, 2002, the Examiner indicated that claims 2-9 were allowed while claims 10-34 were rejected, but further indicated that claims 11, 17, and 21 would be allowable if rewritten in independent form to include all of the limitations of the rejected base claim (claim 10) and that claims 22-34 would be allowable upon submission of an acceptable supplemental oath/declaration. The Examiner maintained his rejection of claims 10, 12-16, and 18-20 under 35 U.S.C. §251 as being an improper recapture, essentially restating the above-quoted reasoning for rejection from the Office Action mailed July 24, 2001. The Examiner also noted a suggested change in the language of claims 7, 8, 15, 21, 28, and 34. That language change was subsequently added to those claims and claims 11 and 17 were rewritten in independent form. New claims 35 and 36 were presented for examination, depending from independent claims 10 and 16, respectively, both adding the provision of a spring operably coupled with the first end of the drawbar. Additionally, a Supplemental Declaration was submitted.

In an Advisory Action mailed March 6, 2003 in response to an Amendment After Final, the Examiner indicated that claims 2-9, 11, 17, and 21-36 were allowed, that claim 35 would be allowable if rewritten to overcome the rejection under 35 U.S.C. §112, second paragraph, and claim 36 would be allowable if rewritten in independent form. The Examiner maintained the rejection of claims 10, 12-16, and 18-20 under 35 U.S.C. §251 as being an improper recapture, again restating the above-quoted reasoning for rejection from the Office Action mailed July 24, 2001. In another Amendment After Final filed June 4, 2003, claims 35 and 36 were both rewritten in independent form and claim 35 was amended as suggested by the Examiner to overcome the rejection under 35 U.S.C. §112, second paragraph. In the Office Action mailed June 12, 2003, the Examiner indicated that for purposes of the Appeal, the amendment would be entered can claims 35, 36 allowed.

B. Legal Background

The recapture “rule” relied upon by the Examiner is a court created equitable doctrine. The Examiner has cited and relied upon three cases in support of his position: *Hester Industries, Inc. v. Stein, Inc.* 142 F.3d 14762, 46 USPQ2D 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).

The requirements for a determination of when and how recapture is determined is best set forth in *In re Clements*. *In re Clement* states that the determination of recapture is a multi-step process. 45 USPQ2d 1161, 1164-65:

The first step in applying the recapture rule is to determine whether and in what "aspect" the reissue claims are broader than the patent claims. For example, a reissue claim that deletes a limitation or element from the patent claims is broader in that limitation's aspect. ... Under *Mentor*, courts must determine in which aspects the reissue claim is broader, which includes broadening as a result of an omitted limitation. ...

The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, we look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. *See Mentor* 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 294-98 (Fed. Cir. 1984)

(T)he recapture rule does not apply in the absence of evidence that the applicant's amendment was "an admission that the scope of that claim was not in fact patentable," *Seattle Box Co. v. Industrial Cratong & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984)

Once we determine that an applicant has surrendered the subject matter of the canceled or amended claim, we then determine whether the surrendered subject matter has crept into the reissue claim.

...

In both *Mentor* and *Ball*, the relevance of the prior art rejection to the aspects narrowed in the reissue claim was an important factor in our analysis. From the results and reasoning of those cases, the following principles flow: (1) if the reissue claim is as broad as or broader than the canceled or amended claim in all aspects, the recapture rule bars the claim; (2) if is narrower in all aspects, the recapture rule does not apply but other rejections are possible; (3) if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; (b) if the reissue claim is narrower in an aspect germane to prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible. *Mentor* is an example of (3)(a); *Ball* is an

example of (3)(b).

C. **Detailed Argument**

1. **The Examiner's Position is Unsupported By Law**

a. **The Examiner's position is contrary to the Patent Rules.**

Initially and dispositively, the Examiner's position is contrary to 37 C.F.R. 1.109 *Reasons for Allowance* in effect at the time of the October 31, 1995 allowance of the subject patent's application. That Rule stated:

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing the claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims . . . or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. **Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.** [Emphasis added.]

A copy of the then governing Rule is attached as XI Appendix for verification.

The only basis relied upon by the Examiner for acquiesce of Applicant to the Examiner's position on allowability of the claims is Applicant's lack of a response to the Examiner's stated reason for allowance. Under 37 C.F.R. 1.109 in effect of that time, neither the Examiner nor the public could rely upon the Applicant's or Patentee's non-response to a stated reason for allowance as an acquiescence to the Examiner's reasoning. The rule is explicit that the lack of a reply shall not give rise to any implication of agreement or acquiescence and that is precisely what the Examiner has done. While this rule was changed well after the allowance of the parent application, it is, nevertheless, the controlling rule for the determination of this appeal. The sole basis relied upon by the Examiner for evidence of applicant's agreement or acquiescence is thus expressly prohibited by rule, and therefore the issue of recapture is unsupported by law.

b. **The cases cited by the Examiner do not support the Examiner's position.**

While the three cases cited by the Examiner (*Hester, Clement, Ball*) outline the parameters of the recapture doctrine, they provide no support for his particular application of that doctrine to reject claims 10, 12-16 and 18-20 in the present application. None of the cited cases

involves a case exactly like the present application where the claims in question in the original application were indicated to be allowable over the prior art in the very first office action and never rejected over the prior art during the prosecution of the underlying patent. However, to the extent that these cases support either party, they support applicant.

In *Ball*, the third case relied upon by the Examiner, the court found that the recapture rule did not apply in a case factually more closely related to the present application than either *Clement* or *Hester*. The latter pair of cases involved reissue of claims that were amended during prosecution to distinguish over prior art and which were allowed based upon such amendment and argument. In *Ball*, an independent application claim 7 and a dependent claim 8 were rejected in a first Office Action over the prior art while a dependent claim 9 was indicated to be allowable. Claim 8 called for “at least one” conductive lead while claim 9 required “a plurality of leads”. After the claims were amended in other ways, the Examiner repeated the rejection of claim 8 and suggested the allowability of the plurality of lead line claims if presented in independent form. The claims were again amended to require “a plurality of leads” and were subsequently allowed. *Ball*, 221 USPQ at 291.

In the reissue application of *Ball*, which was filed within two years of the grant of the original patent, the applicant presented new claims which eliminated the requirement for a “plurality of leads” and further eliminated a requirement in the broadest allowed patent claim that the antenna be of a cylindrical configuration. Despite these two broadening changes, the court still found that the granted reissue claims were sufficiently narrower than the cancelled claims to avoid the recapture rule. *Ball*, 221 USPQ at 292. Equally important as the broadening that was permitted in *Ball* is the fact that the court did not take the applicant’s decision to follow the Examiner’s suggestion to accept certain claims or subject matter as being allowable as evidence that the applicant had admitted the scope of the originally canceled claims were not patentable.

The cases cited by the Examiner simply do not support the application of the recapture rule in this application.

2. The Examiner’s Position is Factually Unsupported on Numerous Grounds
a. The Applicant was Under no Obligation to Respond.

The Examiner asserts that Applicant was obligated to respond if Applicant disagreed with the Examiner’s opinion. In fact, the Examiner gave Applicant the option to decide whether a

response was necessary under the circumstances. The Examiner did not simply invite the Applicant to “submit any comments considered necessary.” Unfortunately for the Examiner’s argument now, the Examiner expressly invited the Applicant to submit “any comments considered necessary **by applicant...**” (Emphasis added.) The form of the Examiner’s invitation makes applicant the sole determiner of what was considered necessary for response. The Examiner cannot now complain that the Examiner now thinks it was necessary that comments should have been made by the Applicant under the circumstances.

b. There Was No Reason For Applicant To Have Contested the Portion of the Examiner’s Reason for Allowance Being Relied Upon By the Examiner Since It Was Nothing More Than A Statement of the Examiner’s Obligation.

The portion of the Examiner Reason for Allowance that the Examiner now relies upon for Applicant’s acquiescence was, on the one hand, merely a factually correct statement of the law and his obligations and was therefore incontestable. The Examiner is expected to review all claims for allowability over the prior art under 35 USC §§ 102 and 103. Under MPEP 2141, the Examiner **must** consider “the claimed invention...as a whole.” This means he must consider all of the elements/features of the claims in determining patentability. Indeed, he is not permitted to consider anything less. Accordingly, the portion of the Examiner’s statement of reason for allowance that he points to is truly nothing more than a restatement of his obligations under the statutes, the regulations and rules and the MPEP, which would not merit or warrant a response from the Applicant let alone a protest.

c. The File History Makes Clear That the Examiner Was Not Relying On “all of the elements of claim 7”, As Now Asserted, For Allowance of Claim 7 of the Parent Patent Application.

The reason for the seeming irrelevance of the language the Examiner is now relying upon to support the rejection is that that language is taken out of context. What is more telling is the quoted portion of the reason for allowance he chooses now not to emphasize, namely “in particular with the use of two stops on the coupling head for limiting the pivotal movement of the coupling knuckle against the spring...” This is the express language of original application claim 4, which was never rejected over the prior art and for which Applicant never argued or had need to argue for patentability. In the parent patent application, the Examiner had found all of the features of original application claim 1 from which application claim 4 depended and repeatedly rejected application claim 1. He also allowed claim 4 in his first action and repeated

his allowance of that claim and corresponding independent claim 7 in each subsequent action. He never referred to the features of claim 4, the pair of stops contained in the coupler body which limit movement of the coupler knuckle, as being found in any of the prior art of record. Indeed, it is clear from the file history that he was unable to find any art showing the claimed pair of stops in a coupler body or any coupler assembly or in any analogous art. The file history clearly discloses that the Examiner lacked any art showing stops and therefore was unable to reject any coupler claim calling for such stops.

The Examiner's current position that he relied upon all the elements of patent claim 1 to allow that claim is further undercut by his treatment of claims 10, 12-16, and 18-20 being rejected in the present reissue application. He has allowed all of these claims over the prior art. If he had truly been relying upon all the elements of patent claim 1 for the original allowance of that claim, he should have had prior art available that would cover any claim that was broader in any respect than patent claim 1. Clearly he did not and does not.

d. The File History Suggests That The Examiner Provided The Statement of Reason for Allowability For A Different Reason.

The Examiner would have this Board believe that the Statement of Reason for Allowance was added to the Notice of Allowance to warn Applicant that the Examiner was relying upon all of the elements of parent patent application claim 7 to allow that claim to become patent claim 1 and that the Applicant should have responded to that warning to preserve his rights. However, it has been demonstrated above that the portion of the Statement of Reason of Allowance that the Examiner relies upon is nothing more than a restatement of the legal requirements of his obligations for examination. This would seem to make the purpose of providing Statement a meaningless exercise. There is a portion of the Statement of Reason that is not *pro forma* and does provide an explanation why a Statement of Reason was even included. The end of the same sentence that provides the language that the Examiner now relies upon, includes further language that the Examiner pointedly now ignores. The language that the Examiner does not rely upon or even quote from the sentence he does rely on is: "The combination of...features...is not found nor suggested by any of the prior art of record, **including the exhibits of the protest filed 10/10/95.**"[Emphasis added.] A third party protest to the granting of a patent on this application was filed while the application was pending. It is nowhere reflected in the file history of this application before its acknowledgement by the Examiner here in the reasons for allowance and in the telephone interview summary.

When considered as a whole, it appears that the primary reason for the Examiner's inclusion of a statement of the reasons for allowance was not to warn applicant that he (the Examiner) was relying upon and considered essential all of the elements of application claims 4 and 7 for the allowance of those claims. Rather, the primary purpose of the Statement of Reasons appears to be to give notice to all that he (the Examiner) had considered the patentability of claims against the prior art of the protest, which was neither expressly cited nor made of record in the application, and still found the claims, " in particular" with the "pair of stops" feature of originally allowed claim 4, to be allowable over this art as well. When considered as a whole, it can be seen that the beginning of the Examiner's Statement of Reasons (upon which he now relies) was actually a pro forma Statement and the real reason for even providing a Statement was to notify the public that he had considered these allowed claims in view of the presented but not cited protest prior art. Applicant certainly had no reason to contest that portion of the Statement either.

3. The Effect of Imposing the Recapture Rule On Applicant Under These Facts Constitutes A Denial of Equal Protection Under the Law

Allowing the Examiner to now rely upon a statement of reasons for allowance and, in particular, a portion of that statement that merely recites what the Examiner is required under law to do in examining and allowing claims, denies Applicant the rights under 35 USC §251 Applicant would have otherwise been entitled to and, therefore, denies Applicant equal protection under the law.

When Applicant's patent first issued, it was immediately endowed by law with a presumption of validity. That means it was legally presumed to have been examined and allowed according to law and to the rules and regulations relating to examination. It further means specifically that the Examiner is presumed to have considered each of the allowed claims as a whole and found them not to be obvious over the prior art.

Patentees whose applications are allowed without an express restatement of the law under which the Examiner must examine and allow claims are not required to file any statement contesting the allowance of their claims in order to preserve their right to seek a broadening reissue examination. If that were the case, there effectively would be no grounds for a broadening reissue under 35 U.S.C. 251. Denying applicant his statutory right under 35 U.S.C. 251 to a broadening reissue merely because the Examiner recites that he has done what he is

supposed to do, denies applicant the same protection afforded patent owners whose examiners are not so "helpful". The failure to treat the present Applicant in the same way as patent owners whose patent application claims are allowed without an express restatement of the criteria for allowance, is to treat patent owners unequally under the law in violation of Applicant's due process rights under the Fifth Amendment of the U.S. Constitution.

4. The Effect of Imposing the Recapture Rule On Applicant Under These Facts Is Inequitable.

The recapture rule is an equitable doctrine. The foregoing reasons of why this recapture is unsupported by law or fact and why it denies Applicant equal protection under the law also makes clear that it is not being applied equitably. There is certainly no equity in treating this applicant (and similarly situated applicants) differently from any other patentee who has his claims allowed without a restatement of the criteria for examination by the Examiner.

D. Summary


For the reasons set forth above, Applicant submits that the Examiner has failed to meet his burden of showing that the appealed claims 10, 12-16, and 18-20 are invalid for any reason and further that there is no other basis anywhere in the record or under law or equity supporting the imposition of that rule to reject claims 10, 12-16, and 18-20. Accordingly the rejection of claims 10, 12-16, and 18-20 must be REVERSED and claims 10, 12-16, and 18-20 allowed.

Respectfully submitted,

ROBERT H. STAAT

4 Aug. 2003
(Date)

By:


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IX.
APPENDIX OF CLAIMS
INVOLVED IN THE APPEAL

10. A magnetically-actuated coupler assembly for a model railroad car comprising:

(a) drawbar with first and second ends, the first end being configured for pivotal mounting within a coupler pocket of a model railroad car;

(b) a coupler head at the second end of the drawbar,

(c) a magnetically-actuated post pivotally secured to the drawbar so as to extend downward from the drawbar,

(d) a coupler knuckle pivotally secured to the second end of the drawbar with the post, the coupler head having a pair of stops which limit the pivotal movement of the coupler knuckle on the drawbar, and

(e) a cantilever spring formed as an integral part of the drawbar, the cantilever spring including a first portion extending from the drawbar proximally the coupler head which curves away from the drawbar and the coupler knuckle and a free end which curves back toward the coupler knuckle sufficiently so as to constantly apply a tangential force against the coupler knuckle and urge the coupler knuckle to a closed or coupled position in all positions of the coupler knuckle between the pair of stops.

12. The magnetically-actuated coupler assembly of claim 10 wherein the outer tip of the coupler knuckle contains a lip which extends inward toward the post.

13. The magnetically-actuated coupler assembly of claim 10 wherein the drawbar includes an extension lip, extending from the drawbar.

14. The magnetically actuated coupler assembly of claim 10 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

15. The magnetically-actuated coupler assembly of claim 10 wherein the cantilever spring and the drawbar are molded together as a unitary piece from engineering plastic.

16. A magnetically-actuated coupler assembly for a model railroad car comprising:

a drawbar having a first end adapted to be pivotally mounted within a coupler pocket of a model railroad car and an opposing, second end,

a coupler head formed on the second end of the drawbar,

a cantilever spring formed as an integral part of the drawbar extending from the drawbar adjacent to the coupler head;

a coupler knuckle pivotally secured to the coupler head; and

a magnetically-actuated post pivotally securing the coupler knuckle to the coupler head, the magnetically-actuated post being pivotally connected to and extending at least downwardly from the coupler head, the coupler knuckle being in constant contact with the cantilever spring to urge the coupler knuckle to a closed or coupled position, the cantilever spring having a first portion which curves away from the drawbar and a free end which curves back toward the coupler knuckle to apply a tangential force to the coupler knuckle, such that the magnetically-actuated coupler is assembled from three parts, and

the coupler head containing a pair of stops which limit the movement of the pivotally mounted coupler knuckle.

18. The magnetically-actuated coupler assembly of claim 16 wherein the outer tip of the coupler knuckle contains a lip which extends inward toward the post.

19. The magnetically-actuated coupler assembly of claim 10 further comprising a leaf spring secured to the first end of the drawbar and extending outward and around the first end of the drawbar to form a C-shape.

20. The magnetically actuated coupler assembly of claim 16 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

X.

APPENDIX OF ORIGINAL CLAIMS

PROSECUTED IN PARENT APPLICATION 09/292,880

1. A magnetically-actuated coupler assembly for a model railroad car comprising
 - (a) a drawbar with first and second ends, pivotally mounted within a coupler pocket in the end of a model railroad car;
 - (b) secured to the first end of the drawbar is an integral leaf spring extending from the first end of the drawbar,
 - (c) secured to the second end of the drawbar is a coupler head;
 - (d) a cantilever spring secured to the drawbar proximal from the coupler body,
 - (e) a magnetically-actuated post pivotally secured to the drawbar which extends downward from the drawbar, and
 - (f) a pivotally mounted coupler knuckle, pivotally secured to the post and to the second end of the drawbar such that it interacts with the cantilever spring to urge the coupler knuckle to a closed or coupled position.
2. The magnetically-actuated coupler assembly of Claim 1 wherein the leaf spring is secured to the first end of the drawbar and extends outward and around the first end of the drawbar to form generally a C-shape.
3. The magnetically-actuated coupler assembly of Claim 1 wherein an outer tip of the coupler knuckle contains a lip which extends inward toward the post.
4. The magnetically actuated coupler assembly of Claim 1 wherein the coupler body contains a pair of stops which limit the movement of the coupler knuckle.
5. The magnetically actuated coupler assembly of Claim 1 wherein the coupler knuckle includes an extension lip, extending from the drawbar.

6. The magnetically-actuated coupler assembly of Claim 4 wherein the coupler knuckle contains a slot, an edge of which interacts with a stop of the coupler body to limit the capability of the coupler knuckle to open.

7. A magnetically-actuated coupler assembly for a model railroad car comprising

- (a) a drawbar with first and second ends, capable of being pivotally mounted within a coupler pocket in the end of a model railroad car,
- (b) formed as an integral part of the first end of the drawbar is a leaf spring extending from the first end of the drawbar,
- (c) secured to the second end of the drawbar is a coupler head, wherein the coupler head contains a pair of stops which limit the movement of the coupler knuckle;
- (d) a cantilever spring formed as an integral part of the drawbar located proximal from the coupler body,
- (e) a magnetically-actuated post pivotally secured to the drawbar which extends downward from the drawbar, and
- (f) a pivotally mounted coupler knuckle, pivotally secured to the second end of the drawbar such that it is in constant interaction with the cantilever spring to urge the coupler knuckle to a closed or coupled position.

8. The magnetically actuated coupler assembly of Claim 7 wherein the coupler knuckle contains a slot, an edge of which interacts with one of the stops of the coupler head to limit the capability of the coupler knuckle to open.

cant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(c) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to § 1.107.

(d) Subject matter which is developed by another person which qualifies as prior art only under 35 U.S.C. 102(f) or (g) may be used as prior art under 35 U.S.C. 103 against a claimed invention unless the entire rights to the subject matter and the claimed invention were commonly owned by the same person or organization or subject to an obligation of assignment to the same person or organization at the time the claimed invention was made.

(e) The claims in any original application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the same subject matter is claimed in the application and the statutory invention registration. The claims in any reissue application naming an inventor will be rejected as being precluded by a waiver in a published statutory invention registration naming that inventor if the reissue application seeks to claim subject matter (1) which was not covered by claims issued in the patent prior to the date of publication of the statutory invention registration and (2) which was the same subject matter waived in the statutory invention registration.

[24 FR 10332, Dec. 22, 1959, as amended at 34 FR 18957, Nov. 26, 1969; 47 FR 21752, May 19, 1982; 50 FR 9381, Mar. 7, 1985]

§ 1.107 Citation of references.

(a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees, and the classes of inventions must be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated.

and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

(b) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

[46 FR 29182, May 29, 1981]

§ 1.108 Abandoned applications not cited.

Abandoned applications as such will not be cited as references except those which have been opened to inspection by the public following a defensive publication.

[50 FR 9381, Mar. 7, 1985]

§ 1.109 Reasons for allowance.

If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure to file such a statement shall not give rise to any implication that the applicant or patent owner agrees with or acquiesces in the reasoning of the examiner.

[46 FR 29182, May 29, 1981]

§ 1.110 Inventorship and date of invention of the subject matter of individual claims.

When more than one inventor is named in an application or patent, the Patent and Trademark Office, when necessary for purposes of an Office proceeding, may require an applicant, patentee, or owner to identify the inventive entity of the subject matter of each claim in the application or patent. Where appropriate, the invention dates of the subject matter of each claim and the ownership of the subject matter on the date of invention may be required of the applicant, patentee or owner. See also §§ 1.78(c) and (d).

(Approved by the Office of Management and Budget under control number 0651-0018)

[50 FR 9381, Mar. 7, 1985]

ACTION BY APPLICANT AND FURTHER CONSIDERATION

AUTHORITY: Secs. 1.111 to 1.113 also issued under 35 U.S.C. 132.

§ 1.111 Reply by applicant or patent owner.

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how

the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in response to a rejection of claims in an application or patent undergoing reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. (See §§ 1.135 and 1.136 for time for reply.)

[46 FR 29182, May 29, 1981]

§ 1.112 Reconsideration.

After response by applicant or patent owner (§ 1.111), the application or patent under reexamination will be reconsidered and again examined. The applicant or patent owner will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant or patent owner may respond to such Office action in the same manner provided in § 1.111, with or without amendment. Any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made. The application or patent under reexamination will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

[46 FR 29182, May 29, 1981]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must com-